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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/617,489	
	Filing Date	July 10, 2003	
	First Named Inventor	Thomas L. CANTOR	
	Art Unit	1641	
	Examiner Name	C. Cheu	
Total Number of Pages in This Submission	16	Attorney Docket Number	532212000623

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement – Supplemental (11 pages) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Form PTO/SB/08A/B (2 pages + duplicate) References (17) Return Receipt Postcard
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Peng Chen		
Date	August 5, 2008	Reg. No.	43,543

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 781791031 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: August 5, 2008

Signature:

(Anthony Matson)

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AMat
(Anthony Matson)



Patent

Docket No. 532212000623

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES
FOR DETECTING PARATHYROID
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

**SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.97 and § 1.98, Applicants submit for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of the foreign document and non-patent literature documents are also submitted herewith. The Examiner is requested to consider and make these documents of record.

Document numbers 1-6 are all published patent applications or granted patents that the Applicants have filed. None of them are in the same patent family as the present application, but they are related to PTH tests.

Document number 7 issued on June 6, 2008 in Japan and is related to the present patent application. Document number 8 is from an EP Opposition proceeding against EP Patent No. 1 151 307, which is related to the present patent application. Document numbers 9 and 10 were cited in

sd-436105

document number 8 and have not been specifically listed by themselves in previously submitted Information Disclosure Statements (they were included as part of Cantor Exhibit List and Exhibits from Patent Interference No. 105,575 (MPT). The other 3 documents cited in document number 8 have all been previously submitted in Information Disclosure Statements as non-patent literature.

Document numbers 11-13 are from Patent Interference No. 105,575 (MPT), between related Application No. 10/641,780 and U.S. Patent No. 6,838,264. Document number 14 is from the prosecution of related Application No. 10/945,608.

Document numbers 15-23 are from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, in the United States District Court for the Central District of California, Case No. CV 04-08871 MRP (MANx). This litigation involves U.S. Patent No. 6,689,566. The present application is Continuation-in-Part of U.S. Patent No. 6,743,590, which is a Continuation-in-Part of U.S. Patent No. 6,689,566. Scantibodies Laboratory, Inc. is the assignee of the present application. Document number 21 is a Judgment.

As pointed out previously, U.S. Patent No. 6,689,566 ('566 patent), has been involved in litigation. As part of that litigation, the defendant in that litigation, Immutopics, Inc., has asserted non-infringement, invalidity and unenforceability of the '566 patent and has submitted various documents related to its non-infringement, invalidity and unenforceability assertions in that litigation. In the Supplemental Information Disclosure Statement submitted on December 6, 2007, Applicants submitted under seal the following Immutopics' documents from that litigation:

- Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment for Failing to Disclose the Best Mode, filed November 13, 2007 (document number 1);
- Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment for Failing to Disclose the Best Mode, filed November 13, 2007 (document number 2);

- Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Violation of On Sale Bar and for Obviousness over the Prior Art, filed November 13, 2007 (document number 3);
- Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Violation of On Sale Bar and for Obviousness over the Prior Art, filed November 13, 2007 (document number 4);
- Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Lack of Enablement, filed November 13, 2007 (document number 5);
- Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Lack of Enablement, filed November 13, 2007 (document number 6);
- Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Non-Infringement of the '566 Patent, filed November 13, 2007 (document number 7); and
- Declaration of Jeffrey Lavigne in Support of Defendants' and Counterclaimants' Motion for Summary Judgment Based on Non-Infringement of the '566 Patent, filed November 13, 2007 (document number 8).

With respect to the "Best Mode" issue, Immutopics alleged that the inventors of the '566 patent used a PTH (1-9) peptide to affinity purify an anti-PTH antibody before the Application No. 09/231,422, which issued as the '566 patent, was filed and the '566 patent fails to disclose the use of a PTH (1-9) peptide to affinity purify an anti-PTH antibody.

In the present application, Applicants submitted on March 6, 2006, as part of a Response to a Non-Final Office Action, a replacement Figure 5, in which the portion of the title referring to Antibody As Tracer is amended to “with PTH 1-[[8]]9 Antibody as Tracer.” A Declaration of Thomas L. Cantor pursuant to 37 C.F.R § 1.132 (Cantor Decl.), explaining the reason for amending Figure 5, was also submitted with the March 6, 2006 Response.

In the reexamination of the ‘566 patent (Serial No. 90/007,685 and 90/007,732), the patent owner also submitted a replacement Figure 5 as part of a Response to the Non-Final Office Action on July 24, 2006. The Examiner in the reexamination of the ‘566 patent objected to the amendment of Figure 5 in the September 21, 2006 Final Office Action as adding new matter. (*See* the September 21, 2006 Final Office Action at pages 6-9.) The patent owner withdrew the amendment of Figure 5 as part of the November 10, 2006 Response to the Final Office Action in the reexamination of the ‘566 patent. (*See* the November 10, 2006 Response to the Final Office Action at page 13.) Patent owner’s July 24, 2006 Response to the Non-Final Office Action was submitted as document number 25 in the Supplemental Information Disclosure Statement on September 8, 2006. The Examiner considered this document in the Office Action dated October 23, 2006. The September 21, 2006 Final Office Action was submitted as document number 24 in the Supplemental Information Disclosure Statement on November 2, 2006. The Examiner considered this document in the Notice of Allowance dated January 4, 2007. Patent owner’s November 10, 2006 Response to the Final Office Action in the reexamination of the ‘566 patent was submitted as document number 12 in the Supplemental Information Disclosure Statement on February 28, 2008.

In a Supplemental Information Disclosure Statement submitted on May 10, 2005, applicants submitted Document numbers 204-223 from a pending civil action for patent infringement: *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, in the United States District Court for the Central District of California, Case No. CV04-8871 GPS (MANx) in connection with the present application. Applicants pointed out to the Examiner in the May 10, 2005 Supplemental Information Disclosure Statement:

- Document numbers 204 to 223 are from a pending civil action for patent infringement based on the ‘566 patent: *Scantibodies v. Immunotopics*. Applicant

wishes to bring the Examiner's attention to the following papers from this proceeding:

- Defendants' Answer to Plaintiff's Complaint and Counterclaims, filed December 3, 2004 (Document No. 208 in the present Form PTO/SB/08a/b), in which unenforceability of the '566 patent is alleged;
- Defendants' First Amended Answer to Plaintiff's Complaint and Counterclaims, filed December 21, 2004 (Document No. 210 in the present Form PTO/SB/08a/b), in which unenforceability of the '566 patent is alleged;
- Defendants' Second Amended Answer to Plaintiff's Complaint and Counterclaims, filed December 31, 2004 (Document No. 211 in the present Form PTO/SB/08a/b), in which unenforceability of the '566 patent is alleged; and
- Plaintiff's Reply to Defendants' Counterclaims, filed January 27, 2005 (Document No. 212 in the present Form PTO/SB/08a/b), in which the alleged unenforceability of the '566 patent is denied.

The Examiner considered Document numbers 204 to 223 submitted with the May 10, 2005 Supplemental Information Disclosure Statement in the Office Action dated December 5, 2005.

U.S. Patent Application Serial No. 10/641,780 (the '780 application), filed August 15, 2003, is a continuation of U.S. Patent Application Serial No. 09/344,639 (the '639 application), filed June 26, 1999, now U.S. Patent No. 6,743,590, which is a continuation-in-part of U.S. Patent Application Serial No. 09/231,422 (the '422 application), filed January 14, 1999, now U.S. Patent No. 6,689,566. The '780 application is currently involved in an interference, Patent Interference No. 105,575 (MPT), with Immunotopics' U.S. Patent No. 6,838,264 B2 ('264 patent).

Immunotopics submitted Zahradnik List of Motions on October 11, 2007, in which Zahradnik alleges that the allowed claims of application number 10/641,780 are invalid and

unenforceable. Applicants submitted Zahradnik List of Motions (as Document No. 6) in Supplemental Information Disclosure Statement on October 15, 2007. Immutopics also submitted the following motions in the interference on December 14, 2007:

- Zahradnik Substantive Motion 1 (Motion for Judgment Under 35 U.S. C. § 135(b)), filed December 14, 2007
- Zahradnik Substantive Motion 2 (Judgment for No Interference in Fact), filed December 14, 2007
- Zahradnik Substantive Motion 3 (Judgment for Lack of Written Description), filed December 14, 2007
- Zahradnik Substantive Motion 4 (Judgment for Lack of Enablement), filed December 14, 2007

Applicants submitted the four Zahradnik substantive motions listed above in a Supplemental Information Disclosure Statement on December 19, 2007. The Examiner considered these documents in the second Notice of Allowance dated April 4, 2008.

Applicants filed the following responses on March 21, 2008:

- Cantor Opposition 1 (Opposition to Motion for Judgment Under 35 U.S.C. § 135(b)), Patent Interference No. 105,575 (MPT), filed March 21, 2008 (submitted as document number 1 in the IDS of March 24, 2008)
- Cantor Opposition 2 (Opposition to Motion for Judgment of No Interference-in-Fact), Patent Interference No. 105,575 (MPT), filed March 21, 2008 (submitted as document number 2 in the IDS of March 24, 2008)
- Cantor Opposition to Zahradnik Motion 3, Judgment for Lack of Written Description, Patent Interference No. 105,575 (MPT), filed March 21, 2008 (submitted as document number 3 in the IDS of March 24, 2008)

- Cantor Opposition to Zahradnik Motion 4, Judgment for Lack of Enablement, Patent Interference No. 105,575 (MPT), filed March 21, 2008 (submitted as document number 4 in the IDS of March 24, 2008)

Immutopics filed the following replies on May 19, 2008:

- Zahradnik Reply 1 (Reply to Cantor Opposition to Zahradnik Motion 1 - § 135(b)) from Patent Interference No. 105,575 (MPT), filed May 19, 2008 (submitted as document number 46 in the IDS of July 2, 2008)
- Zahradnik Reply 2 (Reply to Cantor Opposition to Zahradnik Motion 2 – No Interference-In-Fact) from Patent Interference No. 105,575 (MPT), filed May 19, 2008 (submitted as document number 47 in the IDS of July 2, 2008)
- Zahradnik Reply 3 (Reply to Cantor Opposition to Zahradnik Motion 3 – Written Description) from Patent Interference No. 105,575 (MPT), filed May 19, 2008 (submitted as document number 48 in the IDS of July 2, 2008)
- Zahradnik Reply 4 (Reply to Cantor Opposition to Zahradnik Motion 4 – Enablement) from Patent Interference No. 105,575 (MPT), filed May 19, 2008 (submitted as document number 49 in the IDS of July 2, 2008)

Applicants submitted the following Motions in the interference on December 14, 2007:

- Cantor Substantive Motion 1 – Motion for Benefit to Priority Applications, filed December 14, 2007
- Cantor Substantive Motion 2 – Motion to Change the Count, filed December 14, 2007
- Cantor Substantive Motion 3 – Motion to Correct Inventorship, filed December 14, 2007

Applicants submitted the three Cantor motions listed above in a Supplemental Information Disclosure Statement on December 19, 2007. The Examiner considered these documents in the second Notice of Allowance dated April 4, 2008.

Applicants also submitted the following Motion in the interference on January 18, 2008:

- Cantor Contingent Responsive Motion 1, Contingent Motion to Substitute Claim 47 for Claims in Interference, filed January 18, 2008 (submitted as document number 1 in the IDS of January 25, 2008 and considered in the second Notice of Allowance dated April 4, 2008.)

Immutopics filed the following responses in the interference on March 21, 2008:

- Zahradnik Opposition 1 (Opposition to Cantor Substantive Motion 1 – Motion for Benefit to Priority Applications), Patent Interference No. 105,575 (MPT), filed March 21, 2008
- Zahradnik Opposition 2 (Opposition to Cantor Substantive Motion 2 to Change the Count), Patent Interference No. 105,575 (MPT), filed March 21, 2008
- Zahradnik Opposition 3 (Opposition to Cantor Contingent Responsive Motion 1 – Contingent Motion to Substitute Claim 47 for Claims in Interference), Patent Interference No. 105,575 (MPT), filed March 21, 2008

Applicants submitted the three Zahradnik Oppositions listed above in a Supplemental Information Disclosure Statement on March 24, 2008.

Applicants filed the following replies in the interference on May 19, 2008:

- Cantor Reply 1 (In Support of Motion for Benefit to Priority Applications) from Patent Interference No. 105,575 (MPT), filed May 19, 2008
- Cantor Reply 2 (In Support of Motion to Change the Count) from Patent Interference No. 105,575 (MPT), filed May 19, 2008

- Cantor Reply 3 In Response to Zahradnik Opposition 3 (In Support of Cantor Contingent Responsive Motion 1 to Substitute Claim 47 for Claims in Interference) from Patent Interference No. 105,575 (MPT), filed May 19, 2008

Applicants submitted the three Cantor replies listed above in a Supplemental Information Disclosure Statement on July 2, 2008.

Applicants list below the related applications to the present patent application:

Application Number	Patent Number	Status
09/231,422	6,689,566	Under Reexamination Control No. 90/007,685 Control No. 90/007,732
09/344,639	6,743,590	Granted
09/636,531		Abandoned
10/013,332		Abandoned
10/617,489		Pending
10/641,780		Interference No. 105,575 (MPT)
10/760,091		Pending
10/945,608		Pending
11/799,726		Pending
11/894,367		Pending

Listed below are other applications filed by the Applicants that are related to PTH tests:

Application Number	Patent Number	Status
10/799,476		Pending
09/928,047	6,923,968	Granted
11/894,366		Pending
10/215,770		Pending
09/636,530		Abandoned
10/002,818	6,524,788	Granted
11/377,980		Pending
10/286,465	7,056,655	Granted
09/323,606		Pending
09/928,048		Abandoned
10/209,162		Abandoned
10/265,276		Abandoned
10/674,294		Pending

10/956,760		Pending
11/144,437		Pending
10/958,541		Abandoned
11/516,912		Pending

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☒ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of __ is enclosed.
 - ☐ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of __ is enclosed.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532212000623.

Dated: August 5, 2008

Respectfully submitted,

By: 

Peng Chen

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